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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,307	06/13/2006	Rolf Brisberger	HM-666PCT	8272
40570	7590	07/15/2009		
FRIEDRICH KUEFFNER 317 MADISON AVENUE, SUITE 910 NEW YORK, NY 10017			EXAMINER TUROCZY, DAVID P	
			ART UNIT	PAPER NUMBER
			1792	
			MAIL DATE	DELIVERY MODE
			07/15/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/552,307	BRISBERGER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DAVID TUROCY	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendments, filed 6/1/2009, have been fully considered and reviewed by the examiner. The examiner notes the amendment to claims 1 and 3. In view of these amendments the examiner has withdrawn the 35 USC 112 2nd paragraph rejection. Claims 1-6 are pending in the instant application.

### ***Response to Arguments***

2. Applicant's arguments filed 6/1/2009 have been fully considered but they are not persuasive.

The applicant has argued against the Tada reference, stating that the reference fails to disclose supplying molten metal between the inductors, however, the examiner disagrees, noting Figure 7, which explicitly shows flowing molten metal between at least two inductors arranged on either side of the metal strand. At the very least the modification of Tada reference, to supply the fluid within the passage, between the inductors, rather than immediately above, would have been obvious to have led to predictable results. Additionally, the mere placement of an inlet is considered a design choice, absent a showing of criticality to the location of the inlet, since it has been held that rearranging parts of an invention only involves routine skill in the art. *In re Japikse*, 86 USPQ 70.

The applicant has argued against the Tada reference, stating that the reference do not replenishing the coating metal in order to maintain a desired level of coating

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metal in the tank. The examiner respectfully disagrees. This feature is a necessity in the reference. The claims as written require "that is necessary to maintain a desired level of coating metal in the coating tank", the flow rate of the replenishment fluid will necessarily meet this requirement. The argument appears to be directed at a narrow reading of the claim, where the level of the fluid is only determined by the flow rate of the fluid, however this is clearly not in the claim. The fluid flow into the guide channel will inherently represent a portion of the replenishment volume (inherent in maintaining the level constant, if a coating occurs on the substrate, some material will be removed from the tank) and this flow is necessary to maintain the level of the coating metal in the coating tank constant.

The examiner cites here US Patent 5702528, which explicitly discloses constant replenishment of the fluid. Additionally, the reference discloses supplying fluid between a plurality of inductors in a guide channel (see figure 4).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5965210 by Tada et al., hereafter Tada.

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Tada discloses Method for hot dip coating a steel strip, in which the strip is passed vertically through a coating tank (7) that holds the molten coating metal and through an upstream guide channel (3) of well-defined defined height (H), wherein an electromagnetic field is generated in the region of the guide channel (4) by means of at least two inductors (2a) installed on either side of the metal strand for the purpose of retaining the coating metal in the coating tank, and wherein a predetermined volume flow (Q) of coating metal is supplied to the guide channel in the region of its vertical extent (H), wherein the predetermined volume flow (Q) of coating metal supplied to the guide channel represents a portion of the replenishment volume of coating metal or the entire replenishment volume of coating metal per unit time that is necessary to maintain a desired level (h) of coating metal in the coating tank (see figures, and accompanying text, column 9-11). Tada discloses coating metal supplied between a plurality of inductors on either side of the strip (figure 7).

Claim 2: Tada discloses a closed loop control (Figures).

Claim 3: Tada discloses a device as claimed and discussed with respect to claim 1 above. Tada discloses the supply line opens into the region of the long side and into the region of the short side of the guide channel. The examiner notes the claims require "region" and it is the examiner position that the device as taught by Tada discloses supply lines opening into the region of the short side of the channel as required by the claim.

Claim 4: Tada discloses the supply line dimension is small relative to the guide channel dimension (figures).

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Claim 6: Tada discloses the coating tank is connected to a supply system for coating metal, from which coating metal is conveyed into the supply line or supply lines (see figures, (11).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada.

Claim 1: Tada discloses all that is taught above and the examiner maintains the position as above with regards to the volume flow; however, Tada fails to explicitly disclose the flow rate is to replace volume of coating, however, such would have been obvious because Tada discloses maintaining a height in the bath and a portion of the molten metal would be removed by coating the substrate.

Additionally, Tada discloses coating metal supplied between a plurality of inductors on either side of the strip (figure 7). At the very least, this modification would have been obvious to one of ordinary skill in the art at the time of the invention because Tada, at figure 7, discloses supplying fluid in an area between the plurality of inductors would led to predictable results of hot dip coating of a metal strand. Additionally, the mere placement of an inlet is considered a design choice, absent a showing of criticality

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to the location of the inlet, since it has been held that rearranging parts of an invention only involves routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 2: Tada discloses the volume flow (Q) of coating metal that is supplied to the guide channel is supplied under open-loop or closed-loop control (see figures, Column 13).

Claim 3: Tada discloses all that is taught above and the examiner maintains the position as above with regards to the supply lines; however, Tada discloses supplying molten metal into the guide channel uniformly and therefore it would have been obvious to one of ordinary skill in the art to have modified Tada to provide supply lines around the strip, including into the region of the short side, to uniformly supply molten metal to the guide channel to reap the benefits of uniform supply.

Alternatively, the prior art discloses uniform supply is a design need for the device, there are finite number of predictable solutions, i.e. locations of supply pipes, and the claim would have been obvious because “a person of ordinary skill has good reason to pursue the known options with his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.”

Claim 4-5: Tada discloses the diameter or width of the supply line is small relative to the dimension of the long side (see figures), however, fails to disclose the supply line is no more than 10% of the width of the long side, however, such a modification would have been obvious to one of ordinary skill in the art to provide the appropriate flow of molten metal into the channel and provide a replenishment of the

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molten metal to provide uniform flow throughout the channel. Additionally, it would have been an obvious matter of design choice to choose the size of the supply line, since such a modification would have involved a mere change in the size of a component. A change of size is generally recognized as being within the ordinary level of skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Finally, adjusting the uniformity of the solution by adjusting the supply size would have been obvious because "a person of ordinary skill has good reason to pursue the known options with his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense."

Claim 6: Tada discloses the coating tank is connected to a supply system for coating metal, from which coating metal is conveyed into the supply line or supply lines.

7. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada in view of US Patent 56702528 by Paramonov.

Tada discloses all that is taught above, and while the examiner maintains the position above, the examiner cites here Paramonov. This reference discloses supplying molten metal between inductors in a guide channel is known and suitable in the art (figures). Therefore taking the references collectively, it would have been obvious to one of ordinary skill in the art to have modified Tada to supply the molten metal between the inductors with a reasonable expectation of successful results. As for the requirement "for the purpose of retaining coating metal in the coating tank", this



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is explicitly taught by Paramonov at Column 6, lines 10-20. At the very least, Tada and Paramonov discloses inductors at the bottom of the tank for retaining coating material in the tank and supplying the molten metal between these inductors would have led to predictable results of supplying coating material into the chamber to replenish the coating material leaving the tank on the steel strip.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DAVID TUROCY** whose telephone number is (571)272-

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2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Turocy/  
Examiner, Art Unit 1792